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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/039,120

01/04/2002

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05/03/2006

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EXAMINER

FRENEL, VANEL

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/039,120	HAWASH ET AL.	
	Examiner	Art Unit	
	Vanel Frenel	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>382004; 10282004 & 862005</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the application filed on 01/04/02. Claims 1-30 are pending.

Claim Objections

2. Claim 15 is objected to because of the following informalities: On page 28, claim 15 has ended with a colon, it seems that Applicant's has made a typographical error in the claim. According to MPEP "a claim should be ended with a period". Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greeven et al (2002/0143434) in view of Munoz et al (2002/0052760) .

(A) As per claim 1, Greeven discloses a method of a conducting prescription renewal transaction, the method comprising:

receiving a renewal request of a pharmacy site from a benefits manager in-real time across a network pathway, the renewal request including prescription-related

information of the benefits manager (See Greven, Page 2, Paragraph 0024; Page 4, Paragraphs 0036-0037);

sending the response into the network pathway to the pharmacy site to the renewal (See Greeven, Page 4, Paragraph 0033).

Greeven does not explicitly disclose that the method having transmitting the renewal request to a portable healthcare device to response to the renewal request.

However, this feature is known in the art, as evidenced by Munoz. In particular, Munoz suggests that the method having transmitting the renewal request to a portable healthcare device to response to the renewal request (See Munoz, Page 5, Paragraphs 0058-0059).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Munoz within the system of Greeven with the motivation of sorting approved prescription refill requests. This allows physicians to identify patients who have been given drugs that are being recalled, identify patients who may benefit from new drugs recently approved or identify patients who may qualify for clinical trials for new therapy (See Munoz, Page 2, Paragraph 0020).

(B) As per claim 2, Munoz discloses the method wherein the prescription-related information includes patient formulary, eligibility status, prescription history item cost, at least one alternative parameter or potential drug interferences (See Munoz, Page 4, Paragraph 0043).

The motivation for combining the respective teachings of Greeven and Munoz are as discussed in the rejection of claim 1, and incorporated herein.

(C) As per claim 3, Munoz discloses the method wherein the response includes acceptance conditional on incorporating at least one of the alternative parameter (See Munoz, Page 4, Paragraph 0048).

The motivation for combining the respective teachings of Greeven and Munoz are as discussed in the rejection of claim 1, and incorporated herein.

(D) As per claim 4, Munoz discloses the method wherein the response is an approval or decline of the renewal (See Munoz, Page 3, Paragraph 0039).

The motivation for combining the respective teachings of Greeven and Munoz are as discussed in the rejection of claim 1, and incorporated herein.

(E) As per claim 5, Greeven discloses the method wherein the renewal request includes adjudication results from the benefits manager (See Greeven, Page 2, Paragraphs 0023-0024; Page 4, Paragraphs 0036-0037).

(F) As per claim 6, Munoz discloses the method wherein the adjudication results includes an approval or decline from the benefits manager of the renewal request (See Munoz, Page 3, Paragraph 0039).

The motivation for combining the respective teachings of Greeven and Munoz are as discussed in the rejection of claim 1, and incorporated herein.

(G) As per claim 7, Munoz discloses the method further including preparing the renewal request from the benefits manager to read at the portable healthcare device prior to the transmitting of the renewal request (See Munoz, Page 5, Paragraphs 0058-0059).

The motivation for combining the respective teachings of Greeven and Munoz are as discussed in the rejection of claim 1, and incorporated herein.

(H) As per claim 8, Munoz discloses the method further including preparing the response from the portable healthcare device to read at the pharmacy site prior to the sending of the response (See Munoz, Page 5, Paragraphs 0058-0059).

The motivation for combining the respective teachings of Greeven and Munoz are as discussed in the rejection of claim 1, and incorporated herein.

(I) As per claim 9, Greeven discloses a system to transact a prescription renewal, comprising:

a) an external network port to receive a renewal request of a pharmacy site including prescription-related information of a benefits manager, from the benefits manager in-real time across a network pathway (See Greven, Page 2, Paragraph 0024; Page 4, Paragraphs 0036-0037).

Greeven does not explicitly disclose that the system having b) a renewal processing unit to prepare the renewal request received from a benefits manager for reading at a portable healthcare device; and

c) an internal network port to send the prepared renewal request to the portable healthcare device for response, the external network port further to transfer the response to the renewal request from the portable healthcare device into the network pathway to the pharmacy site.

However, these features are known in the art, as evidenced by Munoz. In particular, Munoz suggests that the system having b) a renewal processing unit to prepare the renewal request received from a benefits manager for reading at a portable healthcare device (See Munoz, Page 5, Paragraphs 0058-0059); and

c) an internal network port to send the prepared renewal request to the portable healthcare device for response, the external network port further to transfer the response to the renewal request from the portable healthcare device into the network pathway to the pharmacy site (See Munoz, Page 5, Paragraphs 0058-0059).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Munoz within the system of Greeven with the motivation of sorting approved prescription refill requests. This allows physicians to identify patients who have been given drugs that are being recalled, identify patients who may benefit from new drugs recently approved or identify patients who may qualify for clinical trials for new therapy (See Munoz, Page 2, Paragraph 0020).

(J) Claim 16 differs from claim 1 by reciting a computer accessible medium having stored therein a plurality of sequences of executable instructions, which, when executed by a processor.

As per this limitation, it is noted that Greeven discloses cause the system to: receive a renewal request of a pharmacy site from a benefits manager in-real time across a network pathway, the renewal request including prescription-related information of the benefits manager (See Greeven, Page 2, Paragraph 0024; Page 4, Paragraphs 0036-0037);

send the response into the network pathway to the pharmacy site to fill the renewal (See Greeven, Page 4, Paragraph 0033) and Munoz discloses transmit the renewal request to a portable healthcare device to response to the renewal request (See Greeven, Page 4, Paragraph 0033).

Thus, it is readily apparent that these prior art systems utilize a computer accessible medium having stored therein a plurality of sequences of executable instructions, which, when executed by a processor to perform their specified function.

The remainder of claim 16 is rejected for the same reasons given above for claims 1 and 9, and, incorporated herein.

(K) As per claim 22, Munoz discloses the computer accessible medium wherein the adjudication results includes at least one suggested alternative parameter (See Munoz, Page 4, Paragraph 0043).

The motivation for combining the respective teachings of Greeven and Munoz are as discussed in the rejection of claim 1, and incorporated herein.

(L) As per claim 25, Greeven discloses a method of verifying a user in a prescription-related transaction, the method comprising:

receiving a renewal request of a pharmacy site from a benefits manager in-real time across a network pathway, the renewal request including prescription-related information of the benefits manager (See Greeven, Page 2, Paragraph 0024; Page 4, Paragraphs 0036-0037);

sending the response into the network pathway to the pharmacy site to the renewal (See Greeven, Page 4, Paragraph 0033).

Greeven does not explicitly disclose that the method having preparing the renewal request from the benefits manager to read at the portable healthcare device prior to the transmitting of the renewal request;

transmitting the renewal request to a portable healthcare device to response to the renewal request;

preparing the response from the portable healthcare device to read at the pharmacy site prior to the sending of the response.

However, these features are known in the art, as evidenced by Munoz. In particular, Munoz suggests that the method having preparing the renewal request from the benefits manager to read at the portable healthcare device prior to the transmitting of the renewal request (See Munoz, Page 5, Paragraphs 0058-0059);

transmitting the renewal request to a portable healthcare device to response to the renewal request (See Munoz, Page 5, Paragraphs 0058-0059);

preparing the response from the portable healthcare device to read at the pharmacy site prior to the sending of the response (See Munoz, Page 5, Paragraphs 0058-0059).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Munoz within the system of Greeven with the motivation of sorting approved prescription refill requests. This allows physicians to identify patients who have been given drugs that are being recalled, identify patients who may benefit from new drugs recently approved or identify patients who may qualify for clinical trials for new therapy (See Munoz, Page 2, Paragraph 0020).

(M) Claims 10-15, 17-21, 23-24 and 26-30 recite the underlying process steps of the elements of claims 2-8, respectively. As the various elements of claims 10-15, 17-21, 23-24 and 26-30 and have been shown to be either disclosed by or obvious in view of the collective teachings of Greeven and Munoz, it is apparent that the apparatus disclosed by the applied prior art performs the recited underlying functions. As such, the limitations recited in claims 10-15, 17-21, 23-24 and 26-30 are rejected for the same reasons given above for method claims 2-8, and incorporated herein.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not the applied art teaches adjudicating pharmaceutical drug sample distribution system and method (2002/0055856), automated pharmacy (6,202,923), remote prescription refill system (6,493,427) and electronic provider-patient interface system (6,757,898).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 571-272-6769. The examiner can normally be reached on 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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April 28, 2006


C. LUKE GILLIGAN
PATENT EXAMINER